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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Signatory Vintage Scotch Whisky Company Limited

Serial No. 79261464

Jeffrey H. Greger of Roberts Calderon Safran & Cole, P.C.
for Signatory Vintage Scotch Whisky Company Limited

Linda Orndorff, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Kuhlke, Bergsman, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Signatory Vintage Scotch Whisky Company Limited (“Applicant”) seeks registration on the Principal Register of the mark KING’S RANSOM in standard characters for “spirits, namely, aged luxury Scotch whisky for private sale only by

invitation” in International Class 33.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark KING’S RANSOM in standard characters for “wines” in International class 33.²

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. The Examining Attorney denied reconsideration, and this appeal proceeded. For the reasons set forth below, we reverse the refusal to register.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry

¹ Application Serial No. 79261464 has a filing date of March 21, 2019 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, as a request for an extension of protection under the Madrid Protocol of International Registration No. 1473484.

² Registration No. 3565916 issued January 20, 2009 on the Principal Register and has been renewed.

mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Similarity of the Marks

We first turn to the *DuPont* factor comparing the applied-for and cited marks, which we consider “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). The marks are identical, so this factor weighs in favor of likely confusion.

B. The Goods, Trade Channels and Classes of Consumers

“[L]ikelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted). The relatedness of goods must be supported by substantial evidence. *In re Viterra Inc.*, 101 USPQ2d 1905, 1907 (Fed. Cir. 2012).

In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Although the Examining Attorney has continued to refer to the original identification

of goods in the registration, “Brandy; Grape wine; Sparkling grape wine; Wine; Wines,” Registrant amended the registration in 2011 to delete everything except “wines” from the identification of goods. That is why the USPTO database displays the other now-deleted goods in brackets. See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1402.12 (2021) (“The Post Registration Section of the USPTO uses single square brackets to indicate that goods/services have been deleted from a registration ... by amendment under 15 U.S.C. §1057”). Thus, in assessing the relatedness of the identified goods, we compare Applicant’s “aged luxury Scotch whisky for private sale only by invitation” only to the “wines” in the cited registration.

The third *DuPont* factor regarding channels of trade and classes of consumers also must be assessed according to the identifications of the respective goods in the application and registration at issue. See, e.g., *Coach Servs.*, 101 USPQ2d at 1722; *Octocom*, 16 USPQ2d at 1787. We must assume that the identified goods move through all normal and usual channels of trade and methods of distribution for such goods and services. *In re i.am.symbolic llc*, 866 USPQ2d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983).

The Examining Attorney points to website evidence that she claims demonstrates “that the relevant goods are sold or provided through the same channels of trade and used by the same classes of consumers in the same fields of use,” including one site that features whiskies and “limited edition spirits” for “experienced Connoisseurs.”³

³ 11 TTABVUE 9-10 (citing sipwhiskey.com).

She also indicates that use-based third-party registrations in the record show that whiskey and wine may emanate from a single source under a single mark.

An overview of her evidence follows:

11 use-based third-party registrations include wine and whiskey among their identified goods;⁴

The website evidence from the No. 209 Distillery pertains to gin and vodka, but does not involve whiskey or wine, except that the gin is aged in wine barrels.⁵

Screenshots from the Black Box website are largely illegible, as they are obscured by pop-ups requiring age verification, but they appear to feature whiskey, vodka, and tequila, but not wine.⁶

Screenshots show Costco's Kirkland Signature mark on both wine and whiskey, as well as gin, vodka, and tequila, but the whiskey is displayed with a \$17.99 sales price and characterized as similar to a "standard go-to well Scotch," rather than a luxury whiskey.⁷

The "Metal+Wine" website shows a banner with a variety of heavy metal and rock bands, and the screenshot features the pages for "Motörhead Wine, Whisky and Beer." The prices are shown in Euros, suggesting that U.S. consumers are not the target audience.⁸

The Fiore Winery & Distillery website shows menu options that include wine and whiskey.⁹

⁴ TSDR August 18, 2020 Office Action at 2-27.

⁵ TSDR August 18, 2020 Office Action at 28-32 (distillery209.com).

⁶ TSDR August 18, 2020 Office Action at 48-52 (blackboxspirits.com).

⁷ TSDR August 18, 2020 Office Action at 33-47.

⁸ TSDR August 18, 2020 Office Action at 53-56 (metal-and-wine.com).

⁹ TSDR August 18, 2020 Office Action at 85-86 (fiorewinery.com).

The DC Wine Guy website features whiskeys under various marks ranging in price from \$44.99 to \$255.99, and the menu of the site suggests that it also features “Wines.”¹⁰

The Sip Whiskey “Online Liquor Store” website bears the tagline “Whiskey Delivered” and offers many types of spirits and wines under various marks. It describes itself as offering “limited edition spirits” and “high end spirits” “for those experienced Connoisseurs.”¹¹

The website of Sherry’s Wine & Spirits shows “Wines” as a menu category, and features rye whiskeys under various marks at prices ranging from \$9.99 to \$199.99.¹²

The Potomac Wines & Spirits website features wines and whiskey under various marks, including one whiskey for \$719.99.¹³

Applicant argues that the Examining Attorney disregarded its specific identification and treated its goods as ordinary whiskey, and therefore “erred by dismissing the importance of the nature of the unique scotch [sic] whisky at issue, its typical consumer, channels of travel, marketing, and the restricted nature of the sale and the buying process.”¹⁴ Applicant introduced evidence of high-end whiskey selling at high prices ranging from \$10,195 to \$460,000 a bottle,¹⁵ and we grant Applicant’s request that we take judicial notice of the definition of “luxury” as “something expensive which is not necessary but which gives you pleasure.”¹⁶ Applicant

¹⁰ TSDR August 18, 2020 Office Action at 62-70 (dcwineguy.com).

¹¹ TSDR August 18, 2020 Office Action at 71-76 (sipwhiskey.com).

¹² TSDR August 18, 2020 Office Action at 77-84 (sherryswine.com).

¹³ TSDR August 18, 2020 Office Action at 57-61 (potomacwines.com).

¹⁴ 8 TTABVUE 6 (Applicant’s Brief).

¹⁵ TSDR January 18, 2020 Response to Office Action at 7-27.

¹⁶ <https://www.collinsdictionary.com/us/dictionary/english/luxury>, accessed July 26, 2021. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v.*

emphasizes that its restricted identification sets its whiskey apart from the ordinary retail channels of trade for whiskey, and limiting sales as private and invitation-only weighs heavily against likely confusion.¹⁷ According to Applicant, the Examining Attorney's evidence pertaining to overlap in the ordinary channels of trade for wine and whiskey does not apply to Applicant's goods.

First, with the exception of Costco's Kirkland house brand that covers an unusually broad range of goods and the foreign Metal+Wine website, both of which we find minimally probative, none of the evidence shows the same mark for both whiskey and wine. Thus, we do not have persuasive evidence that consumers tend to encounter such goods under the same mark, from the same source. *Contrast In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both").

Second, the website evidence involving goods other than whiskey and wine is irrelevant.

J.C. Gourmet Food Imp. Co., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁷ Applicant previously proposed an amended identification (rejected by the Examining Attorney) that specified that its whiskey is "50 year-old aged." TSDR January 18, 2020 Response to Office Action at 1. Applicant introduced articles about the most rare and expensive whiskeys, which were of a similar age. TSDR January 18, 2020 Response to Office Action at 7-27.

Third, the evidence of online retail stores selling whiskey and wine under various marks does not establish relatedness or common trade channels for wine and whiskey “for private sale only by invitation,” because the latter on its face would not be available on an Internet retail site generally available to the public. *Contrast Hewlett-Packard, Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Fourth, while the third-party registrations pertaining to wine and whiskey may “suggest that [wine and whiskey] are of a type which may emanate from a single source,” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998), we find them insufficient to establish the relatedness of wine to Applicant’s “aged luxury Scotch whisky for private sale only by invitation.”¹⁸

The record lacks sufficient evidence to show that wine tends to emanate from the same source or move in the same trade channels to the same classes of consumers as “aged luxury Scotch whisky for private sale only by invitation.” The second and third *DuPont* factors weigh against likely confusion.

C. Sophisticated Purchasing

Relying on the nature of the goods apparent from the face of its identification, and its evidence of the price of very high-end whiskey, Applicant contends that the goods

¹⁸ Applicant did not offer evidence that “luxury” is a term of art for whiskey, but we have taken into consideration the restricted trade channels and class of consumers apparent from the identification, as well as the definition of “luxury” and the evidence of extremely expensive whiskey, including that sold at auction. *E.g.*, TSDR January 18, 2020 Response to Office Action at 7-27.

at issue are sold to wealthy, sophisticated purchasers who make careful purchasing decisions.¹⁹ The Examining Attorney does not argue against this premise, but contends that sophistication in a particular field does not immunize the consumers from source confusion.

The “wines” identified in the cited registration must be construed broadly to encompass all types and price ranges of wines, which includes modestly priced wine purchased by ordinary consumers. However, we agree that on the face of the identification in the application, Applicant’s goods would involve relatively careful purchasing conditions and more sophisticated purchasers. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (“Just from the record description of goods and services here one would expect that nearly all of opposer’s and applicant’s purchasers would be highly sophisticated.”).

Decision: Despite the similarity of the marks, our findings on the other relevant *DuPont* factors regarding the lack of relatedness of the goods and the lack of similar trade channels and classes of consumers who, for Applicant’s goods, would exercise greater care in purchasing, render confusion unlikely. The refusal to register Applicant’s mark is reversed.

¹⁹ 4 TTABVUE 10 (Applicant’s Brief).